

D) REMARKS***Claim Objection***

The Examiner objected to claim 8 for reciting the limitation "the disk blank" with insufficient antecedent basis. Claim 8 has been amended to recite the limitation "the rod blank" which has proper antecedent basis.

Claim Rejections - 35 U.S.C. § 102

The Examiner rejected claims 1-3, 5, 9, 13, 15 and 19 as being anticipated by the Orme reference. The Examiner also rejected claim 13 as being anticipated by the Potter reference.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 1051, 1053 (Fed. Cir. 1987). Applicant respectfully submits that the Orme reference fails to meet this test.

In the Office Action,¹ the proposition is set forth that Orme discloses a handle member, "the handle member having an internal hollow and an external surface." Applicant respectfully disagrees with this statement. In fact, applicant strongly disagrees with this statement because the only way that Orme could even possibly be considered to include a handle member *that has "an internal hollow"* is if the stem 3 somehow removed from the consecutive row of cork rings 1 and carbon rings 2. Of course, that would require one to also "un-glue" the same rings from the stem,² which gluing Orme directs be done to complete that device. This would then leave the user

¹ For example, at page 3, ¶ 4.

² Orme at page 2, lines 21-22.

with nothing more than a useless handle with a hole in it and with no rod blank being inserted into the "hollow" with which to fish.

Orme teaches that, once the consecutive row of cork and carbon rings 1,2 are secured to the stem 3, or rod blank in more conventional terms, the outer surface of the rings 1,2 can be "sanded to form a parallel tube."³ Applicant respectfully submits that Orme's use of the word "tube" in this context is both an unfortunate choice of a word and an inaccurate depiction of Orme's claimed invention. Note also that none of the claims of the Orme reference use the word "tube" either. Orme simply does not disclose a handle that can be considered a "tube," or at least any "tube" that is useful. The real purpose of the Orme device is best summed up at the conclusion of the specification, to wit:

The use of alternate rings of hard and soft material still permits the rod blank or stem to flex in response to the pull of a fish or casting activity of the angler, who is better able to feel the flexion due to the handle being composed of the two types of material.⁴

Thus, the Orme reference teaches the use of rings of hard material *that are in direct contact with the user's hands* and not "vibration disks" that are "attachable to that portion of the fishing rod blank *that is inserted within said hollow handle member.*"⁵ (emphasis added) That is, there is no "hollow" in Orme and the "rings" of Orme's device are not inserted into one. Moreover, even if one were to assume that the notion of a "hollow handle member" was somehow ambiguous in the instant application, which applicant believes it is not,⁶ reference to dictionary definitions would yield the same conclusion. For example, the American Heritage® Dictionary of the English Language

³ Orme at page 2, lines 30-31.

⁴ *Id.* at page 3, lines 4-9.

⁵ Claim 1 of instant application.

⁶ See Fig. 1 of the instant application, as well as the specification at page 7, lines 3-4.

(4th Ed., 2000) defines a "hollow" as "a cavity, gap, or space: *a hollow behind a wall.*"⁷ (usage emphasis in original) Applicant respectfully submits that the Orme reference neither discloses nor claims any such structure. Accordingly, applicant requests consideration of base claims 1 and 13 as well as those claims that depend from them and against which the Orme reference has been cited on the basis of anticipation.

The applicant submits that the Potter reference suffers from a similar problem. While Potter, unlike Orme, does disclose a tubular handle structure, in the form of a metal tube 5, the Potter reference does not include "a plurality of vibration members" wherein vibrations "are transferred through the vibration members and through the handle member."⁸ Rather, Potter discloses and claims "knobs" 16, 17, one of which knobs 17 being movable out of contact with the end of the tube 8.⁹ Moreover, the knobs 16, 17 of Potter are disclosed as being preferably made of "elastic rubber, or other suitable resilient material."¹⁰ Rubber is a known dampening material.¹¹ Also, the stated purpose of the Potter invention is to provide a rod "by which the rod may be held with a lateral or swinging movement"¹² Thus, it is respectfully submitted that Potter, by reciting vibration dampening structure, actually *teaches away* from a device where the "knobs" would be used as vibration-transmitting devices, even if the "knobs" were considered to be disk-like members, which applicant does not concede they are. The "knobs" of Potter are not disk-like structures but are rather in the form of a round ball-

⁷ See attached Exhibit A which contains all definitions listed.

⁸ See claim 13 of the instant application at page 15, lines 14-19.

⁹ Potter at Col. 2, Lines 1-2.

¹⁰ *Id.* at Col. 2, Lines 11-12 and Lines 27.

¹¹ See, for example, U.S. Pat. Nos. 4,391,942 and 6,197,885; see also attached Exhibit B which contains a reference from The Columbia Encyclopedia (6th Ed., 2001-05).

¹² *Id.* at Col. 1, Lines 3-4; also specifically note Fig. 3 which shows the sliding knob 17' displaced from the end of the tube 5, an intended function of the Potter device.

like structure that is substantially elongated at its poles and compressed at its equatorial perimeter.

In view of the foregoing, applicant respectfully requests reconsideration of the rejection of claims 1-3, 5, 9, 13, 15 and 19 on the grounds of prior art patent anticipation. Each and every element of the those claims is not found in either the Orme reference or the Potter reference, the Potter reference arguably teaching away from the device of the present invention. The aforementioned claims are believed to be in position for prompt allowance. Allowance is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claims 1-3, 5-9 and 11 as being unpatentable over Potter in view of Venturi.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP § 2142.

Combining prior art references without evidence of such a suggestion, teaching, or motivation "simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight." *In re Dembiczak*, 175

F.3d 994, 999 (Fed. Cir. 1999). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. For example, see *Teleflex v. KSR International*, 119 Fed. Appx. 282 (Fed. Cir. (Mich.) Jan. 6, 2005, No. 04-1152).

Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *In re Dembiczak*, at 999, citation omitted.

The applicant respectfully suggests that the references cited fail to provide either the motivation to combine the references or a reasonable expectation of success. Applicant respectfully submits that one would not learn much about vibration-transmitting disks placed within a hollow handle to dispose the rod blank within the hollow handle and to use the disks to transmit vibration from the blank, through the disks and to the handle by reviewing what is fairly taught by either Potter or Venturi, however they are considered.

By examining what is fairly taught by the Potter reference, it is clear that the Potter device does not disclose or suggest the use of "a plurality of vibration members" wherein vibrations "are transferred through the vibration members and through the handle member."¹³ Rather, Potter discloses and claims "knobs" 16, 17, one of which knobs 17 being movable out of contact with the end of the tube 8.¹⁴ Moreover, the

¹³ See claim 13 of the instant application at page 15, lines 14-19.

¹⁴ Potter at Col. 2, Lines 1-2.

knobs 16, 17 of Potter are disclosed as being preferably made of "elastic rubber, or other suitable resilient material,"¹⁵ rubber being a known dampening material.¹⁶ Also, the stated purpose of the Potter invention is to provide a rod "by which the rod may be held with a lateral or swinging movement"¹⁷ Thus, it is respectfully submitted that Potter, by reciting vibration dampening structure, actually *teaches away* from a device where the "knobs" would be used as vibration-transmitting devices, even if the "knobs" were considered to be disk-like members, which applicant does not concede they are. The "knobs" of Potter are not disk-like structures but are configured in the form of a round ball-like structure that is substantially elongated at its poles and compressed at its equatorial perimeter.

The gap in Potter is not filled by what is fairly taught by Venturi. Venturi teaches the use of friction parts for a telescoping rod. There is no hint or suggestion that the friction parts of Venturi could, would, or even should, be used in the handle of a fishing rod, and Venturi does not so state or even allude to that possibility. Applicant is unclear as to what is meant by the conclusory statement made in the Office Action that "it would have been obvious to one of ordinary skill in the art to take the device of Potter and add the disks of Venturi, *so as to allow for the movement of the fishing rod to be limited and controlled during use.*"¹⁸ (Emphasis added) The friction parts of Venturi are provided to allow for telescoping of sections of the fishing rod in relation to one another, i.e they allow for movement.¹⁹ Applicant is unclear as to how this concept relates to the

¹⁵ *Id.* at Col. 2, Lines 11-12 and Lines 27.

¹⁶ See footnote 11, *supra*.

¹⁷ *Id.* at Col. 1, Lines 3-4; also specifically note Fig. 3 which shows the sliding knob 17' displaced from the end of the tube 5, an intended function of the Potter device.

¹⁸ Office Action at Page 6, end of first paragraph.

¹⁹ Venturi at Col. 1, Lines 26-32; and Col. 2, Lines 44-49.

statement of "limiting" movement or, more importantly, what that concept has to do with vibration transmission within a fishing rod handle. Quite simply, there is no hint or suggestion of using such friction parts *that are essentially non-moving* within the handle of a fishing pole so that such friction parts are also used *to transmit vibrations within the handle*. That simply is not what Venturi was seeking to teach, at least by considering what is fairly contained in Venturi's claimed and disclosed device. In view of these observations and distinctions, it is respectfully submitted that there is no basis, other than by use of impermissible hindsight, to conclude that the applicant's device is obvious in view of what is fairly taught by Potter and Venturi. Allowance of claims 1-3, 5-9 and 11 is respectfully requested.

The Examiner also rejected claim 4 as being unpatentable over Orme or Potter as modified by Venturi as applied to claim 1, and further in view of Tabor. Applicant incorporates by reference his earlier comments relative to the Orme, Potter and Venturi references. As to Tabor, it teaches a hollow handle 6 having a forward rod support 2 and a rear rod support 5.²⁰ Insertable within the hollow handle 6 are a number of storage compartments 10 that include "damping" 21, a "flexible spongy material."²¹ Moreover, Tabor discloses that "a forward portion and rearward portion of pliable grips 4 covers the outside of the hollow handle 6."²² While Tabor does not disclose what "pliable" material is used, the term implies another type of vibration dampening material. Accordingly, applicant submits that Tabor, like Potter, teaches away from the instant invention. Reexamination of claim 4 on the stated basis of rejection for *prima facie* obviousness is respectfully requested.

²⁰ Tabor at Col. 2, Lines 15-17.

²¹ *Id.* at Col. 2, Line 47.

²² *Id.* at Col. 2, Lines 18-19.

The Examiner also rejected claim 10 as being unpatentable over Orme or Potter as modified by Venturi as applied to claim 9, and further in view of Brackett et al. Applicant incorporates by reference his earlier comments relative to the Orme, Potter and Venturi references herein. As to Brackett et al., that reference patent is drawn to a solution for the stated objective of "improving the comfort and stability of casting and spinning rods."²³ To this end, Brackett et al. discloses and claims "an improved handle with a specially contoured reel seat and butt grip."²⁴ Brackett et al. observes that "[t]his construction assures that the user's fingers will be positioned close to the rod blank in the palming position, thereby providing increased sensitivity to rod flexing and vibrations."²⁵ Interestingly, Brackett et al. appears to be an earlier disclosure of that which is essentially taught by Orme,²⁶ Brackett et al. disclosing "a plurality of disks 6a which could be cork-shaped and glued together to form a continuous butt grip of the contour shown."²⁷ The critical difference appears to be that the grip of Brackett et al. is also disclosed and claimed to be in the form of a "partial helix"²⁸

Applicant's earlier arguments to the effect that the only way the Orme reference could be considered to include a handle member *that has "an internal hollow"* is if the stem 3 is somehow removed from the consecutive row of cork rings 1 and carbon rings 2 is reinforced by claim 6 of the Brackett et al. reference. That claim identifies the limitation of "a rod receiving hole ... within [the] handle" but also includes the further limitation that "said rod blank is positioned within said hole." Accordingly, applicant

²³ Brackett et al. at Col. 2, Lines 46-47.

²⁴ *Id.* at Col. 2, Lines 49-50.

²⁵ *Id.* at Col. 3, Lines 54-57.

²⁶ In fact, applicant would submit that the Orme reference is likely unpatentable in view of Brackett et al.

²⁷ Brackett et al. at Col. 4, Lines 35-37.

²⁸ *Id.* at Claim 2; Col. 8, Lines 18-20.

submits the same arguments against Brackett et al. as he submitted against the Orme reference. As with Orme, the only way for the Brackett et al. device to have a handle with a hollow in it is to "un-glue" the same rings from the stem, which would then leave the user with nothing more than a useless handle with a hole in it and with no rod blank being inserted into the "hollow" with which to fish. This is the obvious conclusion by reviewing what is fairly taught by Brackett et al. Accordingly, applicant respectfully requests reconsideration of the obviousness rejection of claim 10 based upon the references cited.

The Examiner also rejected claims 11 and 21 as being unpatentable over Orme as applied to claims 9 or 19, and further in view of Potter. Applicant incorporates by reference his earlier comments relative to the Orme and Potter references herein and requests reexamination of those claims as well.

The Examiner also rejected claim 12 as being unpatentable over Orme or Potter as modified by Venturi as applied to claim 9. Applicant incorporates by reference his earlier comments relative to the Orme, Potter and Venturi references herein and requests reexamination of that claim as well.

The Examiner also rejected claim 14 as being unpatentable over Orme or Potter as applied to claim 13, and further in view of Tabor. Applicant incorporates by reference his earlier comments relative to the Orme, Potter and Tabor references herein. As to claim 14, it is also to be noted that none of the references cited includes a handle member hollow that itself has "a second closed end." To the contrary, applicant submits that Orme has no hollow; that Potter's metal tube 5 is open at the distal end (see Fig. 2); and that Tabor includes a separate end cap 12, the sole purpose of which is to keep the

storage compartments 10 retained within the handle 6. Accordingly, applicant requests reexamination of that claim as well.

The Examiner also rejected claims 15-19 and 21 as being unpatentable over Potter as applied to claim 13, and further in view of Venturi. Applicant incorporates by reference his earlier comments relative to the Potter and Venturi references herein and requests reexamination of those claims as well.

The Examiner also rejected claim 20 as being unpatentable over Orme or Potter as modified by Venturi as applied to claim 19, and further in view of Brackett et al. Applicant incorporates by reference his earlier comments relative to the Orme, Potter, Venturi and Brackett et al. references herein and requests reexamination of that claim as well.

The Examiner also rejected claim 22 as being unpatentable over Orme or Potter as modified by Venturi as applied to claim 19. Applicant incorporates by reference his earlier comments relative to the Orme, Potter and Venturi references herein and requests reexamination of those claims as well.

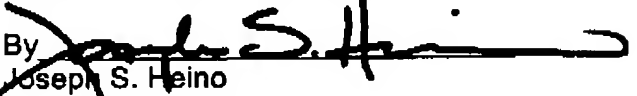
Conclusion

The claims as originally presented, with the sole exception of claim 8, particularly point out and claim the unique apparatus of the present invention which provides a novel amplified fishing rod handle. The prior art references cited against the application are clearly distinguishable under the tests to be applied for novelty, anticipation, and obviousness. The applicant respectfully submits that this novel structure, having the claimed features that it does, is of great benefit to anglers and has not heretofore been

disclosed or claimed by prior invention. It is simple in design as well as unique.

Reconsideration and allowance of all claims now presented is respectfully requested.

Respectfully submitted,
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